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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,628	12/08/2000	Masato Higashi	43890-448	3423

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Washington, DC 20005-3096

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,628

Applicant(s)

HIGASHI, MASATO

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11, 12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-12, 14-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 and 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following statements are not supported in the original specification:

Claim 1: Lines 8-9: “select a firmware of one of said plurality of disk devices”. Line 12: “the selected firmware”

Claim 2: Lines 7-8: “a selecting step of selecting firmware from the firmware of one of plurality of disk devices”. Line 9: “the selected firmware”

Claim 3: Depends on claim 2.

Claim 4: Lines 5-6: “said selected firmware is a firmware of a disk device”

Claim 5: Lines 5-6: “said selected firmware is a firmware of a disk device”

Claim 6: Lines 5-6: “said selected firmware is a firmware of a disk device”

Claim 8: Lines 10-11: “select the selected firmware of one of said plurality of disk devices. Line 12: “the selected firmware”

Claim 11: Depends on claim 2.

Claim 12: Line 2: “the selected firmware”

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-15 rejected under 35 U.S.C. 102(e) as being anticipated by Machida (U.S. Patent 6,209,060).

Claims 14-15: FIG. 1 illustrates a computer system having a plurality of disk devices (30-1 through 30-n) each of which storing firmware (31-1 through 31-n). FIG. 6 illustrates an updating program for updating the firmware of a replaced disk from a reference disk. S1 is the starting step. FIG. 7 is a breakout of the step S5 in FIG. 6 and illustrates step S16 in which a determination is made as to whether the replaced disk has the latest version of firmware. If it is not the latest version, the updating proceeds with steps S6 through S8 of FIG. 6.

Remarks

With respect to claims 1-8 and 11-12, applicant's arguments are moot in light of the new grounds of rejection necessitated by amendment. The original specification does not describe any selecting step, so references to a selection step are new matter.

With respect to claims 14-15, applicant argues that Machida does not disclose updating the firmware of each of the plurality of disk devices to the latest version. This argument is not correct. FIG. 1 clearly illustrates a plurality of disks 30-n each of which having a version of the firmware (31-n). When update is made to the firmware of the multiple disks, the update can be made to each of the disks having firmware in need of updating. The reference to Machida does

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not suggest any exclusion to the system in which only one single disk can ever be updated. It is clear that within the architecture of FIG .1 that all of the disks having a firmware version can be updated with a new firmware version.

This action follows the filing of an RCE and is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'Sam Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
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